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Atty. Dkt. No. 032026-0486

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: WALKER, et al.

Title: FREQUENCY-NARROWED  
HIGH POWER DIODE LASER  
SYSTEM WITH EXTERNAL  
CAVITY

Appl. No.: 09/706,088

Filing Date: 11/03/2000

Examiner: Landau, Matthew C.

Art Unit: 2815

<p><b>CERTIFICATE OF MAILING</b></p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450, on the date below.</p> <p><u>Harry C. Engstrom</u> (Printed Name)</p> <p><u>[Signature]</u> (Signature)</p> <p><u>March 15, 2004</u> (Date of Deposit)</p>
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**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT  
DETERMINATION UNDER 35 U.S.C. § 154(B)(3)(B)(II)**

MAIL STOP ISSUE FEE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants are in receipt of the Notice of Allowance dated December 24, 2003. Applicants' calculation of the patent term adjustment disagrees with the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) submitted with the Notice of Allowance. Applicants present the following facts as set forth in 37 C.F.R. § 1.705 to support their contention that the patent term adjustment reward should be either 339 or 85 days instead of the 24 days calculated by the United States Patent and Trademark Office (USPTO).

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### **BASIS FOR THE ADJUSTMENT**

The Patent and Trademark Office's Determination of Patent Term Adjustment (PTA) shows an adjustment to date of 24 days. Our internal PTA calculation shows that this application should be entitled to an adjustment of at least 85 days and possibly as much as 339 days. The 85 days results from two different calculation terms. The first calculation term compares delays caused by the USPTO to those delays caused by the applicant. The second calculation term results from the number of days in excess of three years from the date of filing the application until the date of issuance of the patent, not including applicant delays. In considering the first calculation term, USPTO delays result in **215** days that extend from January 4, 2002 until August 6, 2002. The USPTO is required to respond to an application within 14 months of filing or January 3, 2002. The USPTO did not respond to the application until August 6, 2002 when a restriction requirement was mailed.

The USPTO calculated applicant delays as 191 days based on an allegedly non-responsive response to the USPTO Office Action mailed October 8, 2002. The response to the Office Action that was mailed March 10, 2003 would have incurred a 61 day applicant delay had it been complete. The USPTO, however, considered the response incomplete based on the USPTO communication of June 4, 2003. The subsequent response was not filed until July 15, 2003 resulting in an applicant delay of 188 days. The USPTO calculated this delay as 191 days based on their receipt of the response on July 18, 2003. The USPTO then calculated the patent term adjustment of 24 days based on the difference between the 215 days of USPTO delay and the 191 days of applicant delay. However, at the very least, the response should have been considered as received on the date of mailing, July 15, 2003, because a certificate of mailing accompanied the response. Thus, the difference should have been **27** days based on subtracting the applicant delay of 188 days from the USPTO delay of 215 days. Additionally, Applicants respectfully submit that the Office Action response mailed March 10, 2003 was responsive. The Examiner objected to amendments made to Claims 1, 13, and 20 because the Examiner considered these claims to be directed to a non-elected species. Claims 1 and 13, however, were ultimately allowed as amended with no further objection regarding these claims as directed to a non-elected species.

As a result, the Applicants delay should have been 61 days instead of 188 days resulting in a difference between the USPTO delays and the applicant delays of 154 days ( $215 - 61$ ). Thus, the first calculation term for PTA results in **154** days for the Applicants.

In calculating the PTA of 24 days, the PTO includes no adjustment for the second calculation term resulting from the number of days in excess of three years from the date of filing the application until the date of issuance of the patent, not including applicant delays. In considering the second calculation term, **246** days are included in the period beginning three years after the application was filed (November 4, 2003) and extending until the patent issues which currently is projected to be July 6, 2004. This period (November 4, 2003 - July 6, 2004) is reduced by periods during which "the applicant failed to engage in reasonable efforts to conclude prosecution." 37 C.F.R. § 1.704(a). The applicant delays related previously are considered circumstances whereby "the applicant failed to engage in reasonable efforts to conclude prosecution." The USPTO calculated the reduction period to be the 191 day delay in responding completely to the first Office Action mailed October 8, 2002. Irrespective of whether or not the Office Action response mailed March 10, 2003 was responsive, the applicant delay was only 188 days. As related above, however, the reduction period should be only 61 days because the Office Action response mailed March 10, 2003 was responsive. Thus, the second calculation term should be at least **58** days ( $246 - 188$ ). Because the Office Action response mailed March 10, 2003 was responsive, the second calculation term should be **185** days ( $246 - 61$ ). Thus, the total patent term adjustment should be at least **85** days ( $27 + 58$ ) or **339** days ( $154 + 185$ ) based on a responsive Office Action response mailed March 10, 2003.

Enclosed herewith is a check in the amount of \$200.00 to cover the requisite fee associated with this request as specified in 37 C.F.R. § 1.18(e) and 37 C.F.R. § 1.705(b)(1)). Furthermore, the Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2350. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even

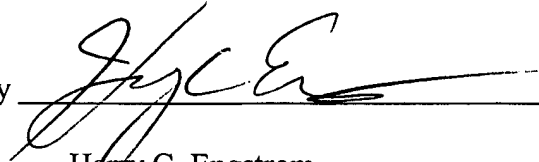
entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit  
Account No. 50-2350.

Respectfully submitted,

Date: March 15, 2004

FOLEY & LARDNER LLP  
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By

A handwritten signature in dark ink, appearing to read 'H. C. Engstrom', written over a horizontal line.

Harry C. Engstrom  
Attorney for Applicant  
Registration No. 26,876